



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Application of Roman Golicz et al.

Serial No. 08/962,077

Date: May 16, 2003

Filed: September 14, 1998

Examiner: D. Bollinger.

Applicant: Roman Golicz et al.

Art Unit: 3651

Title: Sheet Feeding Apparatus

Atty. No. 9534

To: Asst. Commissioner for Patents

*Ed*  
*5/28/03*  
*Petition*  
*#30*  
**RECEIVED**

MAY 22 2003

**GROUP 3600**

PETITION UNDER 37 CFR 1.114 FROM RESTRICTION REQUIREMENT

1. Claims 33-37 and 40-44 were subject to restriction in the office action of 9/28/01.
2. Applicant requested reconsideration and made an election with traverse in the response dated October 15, 2001. The requirement was made final in the office action of 12/3/01.
3. Applicants hereby petitions for withdrawal of said restriction requirement.
4. Applicants hereby enclose a petition fee of \$130. Please charge/credit any deficiency/overpayment to Deposit Account No. 14-0711.

REMARKS

Applicants submit this petition at this time because they believe the rules (MPEP) requires it, inasmuch they also submit a notice of appeal. Applicants believe examiner has been unnecessary ritualistic. The examiner found there were 8 patentably distinct species in what at bottom a simple invention, with various preferred embodiments. Examiner really would think this application would be multiplied 7 times? The examiner was unimpressed by the determination of the UK patent office (without argument) that there was unity of invention for corresponding claims in United Kingdom. Applicants only say it shows a different independent judgment which ought to give pause, toward reconsideration/withdrawal. Applicants will not re-rewrite here their arguments which were made in the traverse of October 15, 2001. Applicant append copies of the 10/15/01 paper and papers showing the examiner's position, for the reviewer's convenience.

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130.00 OP

Respectfully submitted,  
ROMAN GOLICZ et al.

By


*Charles G. Nessler*

\_\_\_\_\_  
Their Attorney

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Assistant Commissioner of Patents, Washington, D.C. 20231 on May 16, 2003.

  
C. G. Nessler



**DETAILED ACTION**

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**GROUP 3600**

9/28/01

***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention: Species I as shown in Fig. 1; Species II as shown in Fig. 10; Species III as shown in Fig. 12; Species IV as shown in Figs. 15-16; Species V as shown in Fig. 17; Species VI as shown in Figs. 19-20; Species VII as shown in Fig. 22; Species IX as shown in Fig. 24; and Species X as shown in Figs. 25-26.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim appears to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Application of Roman Golicz et al.

Serial No. 08/962,077

Date: October 15, 2001

Filed: September 14, 1998

Examiner: H. Skaggs, Jr.

Applicant: Roman Golicz et al.

Art Unit: 3651

Title: Sheet Feeding Apparatus

Atty. No. 9534

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MAY 22 2003

**GROUP 3000**

To: Asst. Commissioner for Patents

THIRD PRELIMINARY AMENDMENT  
AND  
RESPONSE TO RESTRICTION REQUIREMENT

1. Please amend the specification for the third time, as shown in the enclosed marked up copy of the specification bearing even date. A substitute specification, having the present and prior two amendments implemented, is enclosed.

2. Please amend the claims as follows:

Implement the amendments shown on the marked up copy of the claims, attached. A complete set of pending claims 26-44, as amended, is provided.

REMARKS

The Declaration

Applicants enclose a declaration. Although not requested, they submit it in the interest of prudence and completeness, given the torturous pre-examination history of the application.

The Amendments

The specification is amended for clarity and better state what the drawings show and to correct minor errors.

The claims are amended to better state the invention and to hopefully enable alleviation of the restriction requirement. They are discussed further below.

## Response to the Restriction Requirement

Applicants respond to the office action of 9/28/01 (Paper No. 15) and the restriction requirement. Applicants note there was no species VIII.

While examiner follows PTO practice, applicants object to a restriction with respect to Figures, since it is the claims which are to be examined for patentability, and the Figures do not all show the entirety of an invention, but only a fragment thereof. Applicants object to the form of the restriction requirement, because examiner has not supported with reasoning or clarity how or why the species are patentably distinct. See MPEP 814-817. Applicants dispute that there are 9 or 10 patentably distinct species, for reasons stated herein.

Applicants enclose for reference a copy of the cover page and claims from United Kingdom patent GB 2319767. The UK patent claims with minor modifications are those of this present prosecution, excluding UK claims 18-19 and 21.<sup>1</sup> The other UK claims are not in the present application. UK has requirements for unity of invention equal or greater than those of the U.S. The British examiner in a thorough office action did not contend there was lack of unity of claims pending in this present application. (She did assert non-unity with respect to what is now UK claim 19 when it was in independent form. That claim relates to apparatus of the type shown in Fig. 26.)

Applicants elect Species I with traverse for the reasons stated above and below. Claims which read on Species I are 26-36 and 39.

Applicants disagree that there are no generic claims and that the species pictured are patentably distinct, as the examiner asserts in Paper No. 15. Claims 34 and 39 have now been made dependent.

Applicants request reconsideration and reassessment and withdrawal of the restriction, in view of the now-amended claims, the interdependency of the claims, and the facts and argument presented here. Claims 26 and 37 are generic. The claim set 26-36 and 39 also reads on Fig. 10-18 and (Species II-V). The claim set 37, 38, 40-44 read on Fig. 19-24, (Species VI, VII and IX). Some of the latter figure set picture only parts of the claimed inventions, as stated in the Brief Description of the Drawing, in combination with the description text.

## Authorization to Charge Fees

Applicants do not believe any fees are payable. However, if there are any charges, please charge the fees to Deposit Account No. 14-0711.

Respectfully submitted,  
ROMAN GOLICZ et al.

By   
Their Attorney

<sup>1</sup> The correspondence is as follows (the wording is not exactly identical):

British	US
1-8	26-33
9-17	36-44
20	34
--	35

**DETAILED ACTION**

12/3/01

***Election/Restriction***

Applicant's election with traverse of Species I in Paper No. 19 is acknowledged. The traversal is on the ground(s) that the election requirement is based on figures rather than claims and that the examiner has not shown why the species are patentably distinct. This is not found persuasive because it is common office practice to use figures to show different species of an invention. Further any claim directed to the elected species or figure will be examined and thus there is no hardship placed on applicants. Further it would be improper to pick and choose parts of different embodiments and then try to claim them as part of the disclosed invention. Still further the fact that the figures are to different embodiments do in fact show that the species are distinct and, as set forth in the election requirement, if applicants believe the species are not patentable distinct they can so state and the indicated species would be rejoined with the elected species. As to what the British examiner did with a related application, it is irrelevant to the present application since the laws and practice of the two patent offices are different. Applicant sets forth that claim 37 is generic and that claims 26 and 39 read on Species I. Obviously if claim 37 does not read on Species I it is not generic. Further rejoinder will be determined by the examiner at the time of allowance of the application and if a generic claim is present it will then be determined what species can be rejoined with the elected species. Still further the examiner has determined that claims 33-36 are directed to a nonelected species and thus have been withdrawn from consideration. Claim 33 defines a second prompter, claim 34 defines an axle not found

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in the elected species, and claim 36 defines a groove on the prompter belt not found in the elected species.

The requirement is still deemed proper and is therefore made FINAL.

Claims 33-38 and 40-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 19.

***Claim Rejections - 35 USC § 112***

Claim 32 and 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 32 the phrase "between about 1.3:1 and 4:1 of which is triangular and has a height to width aspect ratio of between about 2:1 and 4:1" is not understood. What does this phrase mean? Also it is noted that this phrase might be based on new matter.

With regard to claim 39, the phrase "opposing mounting blocks, slidably and detachably mounted on the apparatus" is not understood. The blocks are part of the apparatus. Are the blocks slidable on themselves? That is what specific part of the apparatus are the blocks slidable along?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action: